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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,382	10/17/2003	Osamu Nishimura	03553/LH	2233
1933	7590	06/27/2005	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 5TH AVE FL 16 NEW YORK, NY 10001-7708			SCHWARTZ, JORDAN MARC	
			ART UNIT	PAPER NUMBER
			2873	
DATE MAILED: 06/27/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/688,382

Applicant(s)

NISHIMURA ET AL.

Examiner

Jordan M. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION*****Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 112***

Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 1-11, claiming a "tip optical element comprising a first optical element and a second optical element" renders the claims vague and indefinite. Specifically, it is not clear if applicant is claiming that the claimed first and second optical elements are the most object side elements within the objective (the assumed meaning for purposes of examination) or if applicant is claiming that the tip optical element can comprise numerous elements and while the "tip optical element" itself is the most object side, the claimed first and second optical elements need not necessarily be the most object side. As a suggestion, if the assumed meaning is correct, it is suggested that in the independent claims applicant claim "the first and second optical elements being the most object side elements within the objective" to provide additional clarity.

In reference to claim 6, that part of the claim stating "a minute lens" renders the claim vague and indefinite because it is not clear how small the lens would need to be to be considered "minute". For purposes of examination the

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assumed meaning is "the third optical element is smaller in size than both the first and second optical elements" and additional clarity is required.

***Claim Objections***

Claims 4 and 7 are objected to because of the following informalities:

1. In claim 4, line 3 "formed a center" should be corrected to "formed at a center";
2. In claim 4, line 3, "sec" should be corrected to "second"; and
3. Claim 7, line 10, the numeral "10" should be deleted.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 5, 7, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagaoka patent number 5,995,295.

Nagaoka reads on these claims by disclosing the limitations therein including the following: a tip optical element for a microscope objective lens system (Figure 1, column 15, lines 25-43); comprising a first and second optical element (Figure 1, column 15, lines 25-43, "Lh" and "Lg"); cemented to each other (Figure 1, column 15, line 31); the first and second optical elements being the most object side elements within the objective (the assumed meaning of tip

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optical element comprising a first and second optical element, Figure 1); an annular light blocking component provided on an interface between the first optical element and the second optical element (Figure 1, "S", column 15, line 34); the light blocking element formed on a surface of one of the first and second optical elements so as to avoid blocking an effective beam (column 15, line 34, column 38, line 60 to column 39, line 4); the surface on which the light blocking area is formed being sandwiched between the first and second optical elements (Figure 1 with "S" sandwiched between "Lh" and "Lg"); the light blocking element formed by a painted material (column 38, line 60 to column 39, line 4); placing beam restricting means on a surface of one of the first and second optical elements (Figure 1, column 38, line 60 to column 39, line 4, the beam restricting means as the stop "S"); and providing a light transmitting area transmitting an effective beam with the light blocking area formed around the light transmitting area (Figure 1). The claimed "for immersion" is set forth in the preamble and has not been given patentable weight. Furthermore, the claimed "for immersion" goes to the intended use of the microscope objective lens system. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d, 1647 (1987).

Claims 1-2, 4-5, 7, 9, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakamura patent number 6,134,056.

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Nakamura reads on these claims by disclosing the limitations therein including the following: a tip optical element for an objective lens system (Abstract, Figure 1); comprising a first and second optical element (Figure 1, "L1" and "L2"); cemented to each other (Figure 1, column 13, line 65); the first and second optical elements being the most object side elements within the objective (the assumed meaning of tip optical element comprising a first and second optical element, Figure 1); an annular light blocking component provided on an interface between the first optical element and the second optical element (Figure 1, "S", column 13, line 62); the light blocking element formed on a surface of one of the first and second optical elements so as to avoid blocking an effective beam (column 13, line 63, column 14, lines 12-19); the surface on which the light blocking area is formed being sandwiched between the first and second optical elements (Figure 1 with "S" sandwiched between "L1" and "L2"); a concave portion formed between a center of the first and second optical elements (Figure 8 embodiment); the light blocking element formed by a painted material or a metal leaf (column 13, line 63); placing beam restricting means on a surface of one of the first and second optical elements (Figure 1, column 13, lines 62-66, the beam restricting means as the stop "S"); and providing a light transmitting area transmitting an effective beam with the light blocking area formed around the light transmitting area (Figure 1, column 13, line 57 to column 14, line 19). The claimed "for immersion microscope" is set forth in the preamble and has not been given patentable weight. Furthermore, the claimed "for immersion microscope" goes to the intended use of the objective lens system. It

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has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d, 1647 (1987).

#### ***Prior Art Citations***

Nagaoka patent number 5,999,327 and Nakahashi patent number 4,354,734 are being cited herein to show objective lens systems that would have read on a number of the above rejected claims, however, such rejections would have been repetitive.

#### ***Allowable Subject Matter***

Claims 3 and 8 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Claims 6 and 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: with respect to the allowable subject matter, none of the prior art either alone or in combination disclose or teach of the claimed combination of limitations to warrant a rejection under 35 USC 102 or 103. Specifically, with reference to independent claim 3, none of the prior art either alone or in combination, disclose or teach of the claimed tip optical element for an immersion microscope objective specifically including, as the distinguishing

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feature in combination with the other limitations, the claimed third optical element embedded at a center of the first optical element and the second optical element. Specifically, with reference to independent claim 8, none of the prior art either alone or in combination, disclose or teach of the claimed method of making a tip optical element for an immersion microscope objective specifically including, as the distinguishing features in combination with the other limitations, the claimed steps of forming a concave portion at the center of the first optical element and the second optical element and further embedding a third optical element in the concave portion.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (571) 272-2337. The examiner can normally be reached on Monday to Friday (8:30 to 4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free)

A handwritten signature in black ink, appearing to read 'J. Schwartz', with a large loop at the end.

Jordan M. Schwartz  
Primary Examiner  
Art Unit 2873  
June 23, 2005